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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,543	09/06/2000	Stefan Kupper	13470.1399US01	8362

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EXAMINER
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MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/655,543

Applicant(s)

KUPPER ET AL.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-25, 31-36, 38-59, 70 and 75-82 is/are rejected.
- 7) ☒ Claim(s) 26-30, 37, 60-68 and 71-74 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Claim Objections***

Claims 60-64 and 70 are objected to because of the following informalities: These claims are drawn to the "method of claim 59"; however, claim 59 is drawn to an aqueous lubricant and not to a method. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23-25, 31-36, 38-59, 69-70 and 75-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-69 of U.S. Patent No. 6,509,302 B2 (Li et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the moving conveyor and container lubricant compositions and methods of applying the composition to the interface between a container and a moving conveyor may be the same when the silicone material is a polyalkylsiloxane. The aqueous solution of the claims "comprises" at least one weight % of a polysiloxane which allows

for the addition of other additives. The lubricant composition of '302 is not necessarily diluted before application as set forth in claim 32.

Claims 23-25, 31-36 and 38-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,495,494 B1 (Li et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of applying a liquid lubricant composition to the interface between a container and a moving conveyor may be the same when the silicone material in the mixture is a polyalkylsiloxane. The mixture in '494 may be applied without requiring in line dilution with significant amounts of water.

Claims 23-25, 31, 40, 42-43 and 46-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 6,427,826 B1 (Li et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods may be the same when the organic phase of the emulsion is a polysiloxane.

Claims 23-25, 31-36, 38-59, 69-70, 75 and 77-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,207,622 B1 (Li et al ). Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods and compositions may be the same when the organic phase is a polysiloxane.

***Claim Rejections - 35 USC § 112***

Claims 77-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how dependent claim 79 further limits the composition of independent claim 59 from which it depends. In dependent claims 77-78, the water content of the aqueous lubricant formulations of claim 59 is limited to less than 20% by weight, or below 10% by weight, based on the formulations as a whole. However, the formulations of claim 59 are aqueous lubricants comprising at least one weight percent of a polysiloxane. It is not clear what comprises the remainder of the composition if water is present at such low levels.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 59, 69, 70 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry et al (5,534,172).

Perry et al ["Perry"] disclose an aqueous-based cutting fluid which comprises (A) at least one antioxidant, (B) one or more surfactants, at least one of which is a polysiloxane surfactant, (C) at least one lubricant, (D) water, and optionally, one or more biocides. The polysiloxane

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surfactant may be present in the composition in an amount of about 0.01 to about 3 parts by weight. See column 3, lines 3-10. The examiner is of the position that Perry meets the limitations of the aqueous lubricant composition of claim 59 which comprises at least one weight percent of a polysiloxane composition based on the lubricant. The intended use preamble language in the independent claim "formulated to lubricate the interface between a moving conveyor and a container to reduce frictional resistance between the conveyor and the containers transported thereon" carries no weight in the composition.

#### ***Allowable Subject Matter***

Claims 26-30, 37, 60-68 and 71-74 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

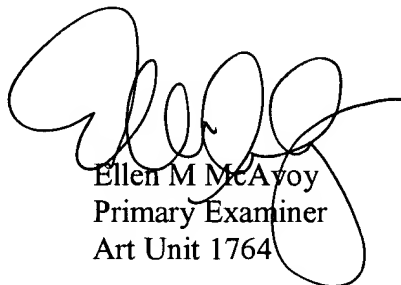
#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
November 4, 2003